

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GANESH CHANDRA DEKA,
CHRISTOPHER JOHN LAWLER,
BILLY DEAN ARNOLD,
DAVID JOSEPH READER,
and
RONALD C. COX

Appeal 2008-1016
Application 10/627,558¹
Technology Center 1700

Decided: 11 February 2008

Before ADRIENE LEPIANE HANLON, CAROL A. SPIEGEL, and
MARK NAGUMO, *Administrative Patent Judges*.

SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application 10/627,558 ("the 558 application") was filed 25 July 2003. The real party-in-interest is said to be Kimberly-Clark Worldwide, Inc. (**Amended Brief on Appeal to the Board of Patent Appeals and Interferences**, filed 2 January 2007 ("App. Br.") at 1).

Ganesh Chandra Deka, Christopher John Lawler, Billy Dean Arnold, David Joseph Reader, and Ronald C. Cox ("Appellants") appeal under 35 U.S.C. § 134 from the final rejection of claims 1-24, 36, and 37.² We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

The appealed claims all require a nonwoven web having at least one abrasion resistant surface, which has a surface roughness of at least 20 μm and a fuzz-on-edge value (which measures "the intensity of protruding fabric loft in perimeter length per unit-edge length," ('558 Spec. at 7:17-8:5)) of less than 1.0 mm/mm (see independent claims 1 and 14).

Claims 1-24, 36, and 37 stand rejected under 35 U.S.C. § 102(b) as anticipated by Pike '045 (US 6,619,045 B1, issued 2 January 2001); and, claims 1-13 and 36 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Pike '749 (US 5,605,749, issued 25 February 1997) (Ans at 3).

Pike '045 teaches a nonwoven filter medium comprising a nonwoven fiber web (Pike '045 at 1:8-9). According to the Examiner, the nonwoven fiber web of Pike '045 inherently possesses the claimed surface roughness and fuzz-on-edge value based on the Examiner's finding that it is formed from the same materials using the same process (Ans. 3). However, the Examiner has not provided a sufficient factual basis to show that the claimed and Pike '045 web products are produced by the same process. Pike '045 describes depositing fibers directly onto a continuous forming surface that is described as a "foraminous [porous] forming surface") (Pike '045 at 6:34-35;

² Claims 25-35, drawn to a nonelected invention, have been cancelled in response to the final rejection (App. Br. at 2; Examiner's Answer mailed 5 April 2007 ("Ans.") at 2). Therefore, claims 1-24, 36 and 37 are the only claims pending in the '558 application.

9:65-67). In contrast, Appellants describe depositing fibers on to a liner material placed on a continuous forming surface ('558 Spec. at 2:24-25; 12:13-20; 14:25-27) that is described in the Examples as a "forming wire" ('558 Spec. at 23:28-29). Both Pike '045 and Appellants describe the use of a vacuum device placed underneath the forming surface to help draw down the fibers of the nonwoven web (Pike '045 at 9:65-67; '558 Spec. at 19:32-20:1).

Pike '045 describes bonding the fibers to form the web (Pike '045 at 6:45-61; 9:67 to 10:2), whereas Appellants describe bonding the fibers and the liner together and subsequently removing the liner to form to web ('558 Spec. at 2:25-28; 12:13-20; 14:32-34 and 15:20-23).

According to Appellants, the presence of the liner is critical to their invention:

Using the process of the present invention to produce the nonwoven web, the side of the nonwoven web which is adjacent the liner is abrasion resistant, has a high degree of surface roughness and a low degree of free fibers on the surface. The other side of the nonwoven web will typically have similar properties to a nonwoven web produced using a conventional process."

('558 Spec. at 16:5-9.) The Examples, especially compared to Comparative Example 2, show the effect of the liner on abrasion resistance, surface roughness, and fuzz-on-end values ('558 Spec. at 23:26 to 26:16).

Thus, the preponderance of the evidence of record fails to support the Examiner's assertion that the claimed and prior art web products are produced by the same process or to shift the burden to Appellants to prove that the prior art products do not necessarily or inherently possess the characteristics of their claimed product. *In re Best*, 562 F.2d 1252, 1255

(CCPA 1977); *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980). Moreover, the Examiner has failed to indicate how Pike '045 meets the surface roughness limitation or the fuzz-on-edge value of the claimed web product. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (anticipation requires a prior art reference to describe every limitation in a claim either explicitly or inherently). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 12689 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Therefore, we REVERSE the rejection of claims 1-24, 36, and 37 under § 102 over Pike '045.

Pike '749 teaches a nonwoven pad comprising a nonwoven fiber web having a soft surface for applying impregnated active agents, e.g., polishing and cleaning agents, and a high fiber density, abrasion resistant surface for buffing and scrubbing (Pike '749 at 1:8-11; 5:23-28). Pike '749 further teaches that spunbond nonwoven webs "are less likely to produce lint, i.e., loose fibers" (*id.* at 5:44-48). According to the Examiner, the fuzz-on-edge value of the claimed web product is anticipated by the low lint property of Pike '749's web product or, in the alternative, would have obviously been provided by preparing the web in accordance with Pike '749's specification and intended use (Ans. at 4).

However, the Examiner has not explained why a low lint property equates to a fuzz-on-edge value of less than 1.0 mm/mm. In particular, the Examiner has failed to provide a basis for determining that the "fuzziness" of the low linting web of Pike '749 would have reasonably been expected to be a fuzz-on-edge value of less than 1.0 mm/mm as required by the claimed

product. Moreover, the Examiner finds that different types of forming surface used to form webs produces webs with different properties (Ans. at 6-7). Pike '749, like Pike '045, describes forming webs on a foraminous surface (Pike '749 at 9:22-26), whereas Appellants describe forming webs on a liner material, said liner on top of a continuous forming surface ('558 Spec. at 2:24-25; 12:13-20; 14:25-27). The Examiner's finding that different forming surfaces produce webs with different properties is inconsistent with the finding that the Pike nonwoven webs inherently have the same properties as Appellants' claimed nonwoven webs. The Examiner has not explained how the Pike nonwoven webs can be reasonably expected to always have the fuzz-on-end value required by the claims. Finally, the Examiner fails to indicate how Pike '749 meets the surface roughness limitation of the claimed web product. All limitations of claimed invention must be taught or suggested by the prior art to establish *prima facie* obviousness. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). Based on the foregoing, we REVERSE the rejection of claims 1-13 and 36 under § 102 as anticipated by or, in the alternative, under § 103 as obvious over Pike '749.

CONCLUSION

In view of the preceding discussion and the Record, it is

ORDERED that the rejection of 1-24, 36, and 37 under 35 U.S.C. § 102(b) as anticipated by Pike '045 is REVERSED;

FURTHER ORDERED that the rejection of claims 1-13 and 36 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Pike '749 is REVERSED; and

FURTHER ORDERED that the case be returned to the Examiner for action consistent herewith.

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REVERSED

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